

REMARKS

Status of the Application

Claims 1-23 are the claims that have been examined in the application. Claims 13-14, 17-18 and 22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4, 11, 15-17, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton (US Patent 7,179,232) in view of Twersky (US Patent 4,445,788). Claims 5-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton in view of Twersky as applied to claim 4 above, and further in view of Juhn (US Patent 4,641,663). Claims 7-10 and 12-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton in view of Twersky as applied to claim 1 and 11 above, and further in view of Shapira (US Patent 6,110,176). Claims 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton in view of Twersky as applied to claim 1 above, and further in view of Morawski (US Publication 2004/0010236).

By this Amendment, Applicants hereby amend claims 1-22, and add new claims 24-26.

Preliminary Matters

The Examiner states that a certified copy of priority application FR 03 12722 has not been filed as required by 35 U.S.C. § 119(b). Applicants respectfully note that a copy of the certified copy of the priority document was provided by the International Bureau.

Applicants respectfully request the Examiner acknowledge acceptance of the drawings filed April 27, 2006.

Applicants thank the Examiner for considering and initialing the references submitted as part of the Information Disclosure Statement filed April 27, 2006.

Specification Objection

Applicants hereby submit a substitute specification in which the Examiner's deficiencies are addressed and corrected.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claims 13-14, 17-18 and 22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants hereby amend claims 13, 14, 17, 18 and 22 to cure the deficiencies noted by the Examiner.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1-4, 11, 15-17, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton (US Patent 7,179,232) in view of Twersky (US Patent 4,445,788).

Claim 1 recites, in part, "said protective sleeve being mounted to move relative to said needle between a closed position of said at least one side orifice and an open position of said at least one side orifice, and said needle holder including reception means that are suitable for co-operating with fastener means of said protective sleeve so as to hold said protective sleeve in the closed position or in the open position." The Examiner alleges that a combination of Sutton and Twersky renders claim 1 obvious. Applicants respectfully disagree.

Sutton discloses a bone marrow sampling device, whereas Twersky discloses an instrument for measuring characteristics of a soil. Applicants respectfully submit that one of

ordinary skill in the art of bone marrow sampling would not consider modifying the bone marrow sampling device disclosed in Sutton with the instrument of Twersky.

As correctly stated by the Examiner, Sutton fails to disclose fastener means on the protective sleeve to engage reception means on the needle holder. The protective sleeve allows an easy handling of the device during surgery. However, according to Sutton, it is desired that needle and the protective sleeve are movable with respect to one another so that bone marrow samples may be taken from various locations in a particular sampling area. Sutton, however, does not desire for the protective sleeve to be placed in a closed position, much less locked, in a closed position. The Examiner argues that one of ordinary skill in the art would modify Sutton with Twersky in order to provide a user with the ability to quickly and assuredly move the orifice between the open and closed positions. However, since Sutton does not indicate that the protective sleeve is to be placed in a closed position, there is no motivation to use a fastener, as disclosed in Twersky, to hold the protective sleeve in an open or closed position.

Further, even assuming *arguendo*, that one of ordinary skill in the art would modify Sutton to hold a protective sleeve in an open or closed position, one of ordinary skill in the art would have no reason to look at a prior art document concerning soil probes. There is no motivation to search a completely unrelated technical field.

Combining Sutton with Twersky thus would not be obvious to one of ordinary skill in the art, and claim 1 is patentable over the Examiner's proposed combination of references.

Claims 2-4, 11, 15-17, and 23 are patentable at least by virtue of their dependency from claim 1.

Claims 5-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton in view of Twersky as applied to claim 4 above, and further in view of Juhn (US Patent 4,641,663).

Claims 5 and 6 depend from claim 1. Because the Examiner's proposed combination of Sutton and Twersky fails to render claim 1 obvious, and because Juhn fails to cure the deficiencies noted with respect to the combination of Sutton and Twersky, claims 5 and 6 are patentable at least by virtue of their dependency from claim 1.

Claims 7-10 and 12-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton in view of Twersky as applied to claim 1 and 11 above, and further in view of Shapira (US Patent 6,110,176).

Claims 7-10 and 12-19 depend from claim 1. Because the Examiner's proposed combination of Sutton and Twersky fails to render claim 1 obvious, and because Shapira fails to cure the deficiencies noted with respect to the combination of Sutton and Twersky, claims 7-10 and 12-19 are patentable at least by virtue of their dependency from claim 1.

Further, with respect to claims 8 and 10, the Examiner states that it would be obvious from Shapira (US6110176) to include the mixing chamber anywhere between the collection chamber and the biopsy site, including the needle holder (claim 8), the handle (claim 9) or an insert (claim 10). Applicants respectfully disagree.

Shapira fails to indicate that the mixing of the bone marrow with the anticoagulant could be provided directly in the extracting apparatus (10), and there is no possible place to provide a mixing chamber in said apparatus, which only provides a passage (53) for the bone marrow extraction. From Shapira, it would be obvious for the skilled person to mix the anticoagulant with the bone marrow once said bone marrow has been transferred out of the extraction passage

(53) of the apparatus, and there would have no reason to modify the apparatus (10) to provide a mixing chamber inside said apparatus.

Additionally, the Examiner also considers that subject-matter of claim 18 would be obvious with respect to Shapira. Applicants again disagree.

Shapira fails to indicate a mixing chamber which provides a Venturi effect inside the mixing chamber to promote the mixing, by projecting the inlet channel of the anticoagulant towards the outlet channel of the mixture (see p. 8, l. 31 - p. 9, l. 2; figure 1). One of ordinary skill in the art would thus not automatically provide a mixing chamber having such a specific structure.

Claims 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton in view of Twersky as applied to claim 1 above, and further in view of Morawski (US Publication 2004/0010236).

Claims 20-22 depend from claim 1. Because the Examiner's proposed combination of Sutton and Twersky fails to render claim 1 obvious, and because Morawski fails to cure the deficiencies noted with respect to the combination of Sutton and Twersky, claims 20-22 are patentable at least by virtue of their dependency from claim 1.

New Claims

Applicants hereby add new claims 24-26. Claims 24 and 25 depend from claim 1 and are patentable at least by virtue of their dependency. Claim 26 recites elements similar to claim 1 and is patentable for reasons analogous thereto.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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